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**MAR 28 2008**

**OFFICE OF PETITIONS**

In re Application of	:	
John I. M. Choate	:	
Application No. 10/780,476	:	DECISION ON PETITION
Filing Date: February 16, 2004	:	PURSUANT TO
Title: APPARATUS THAT IMPROVES	:	37 C.F.R. § 1.137(A)
DISCOVERY OF CANCER MASS, AND	:	
REDUCES INFLAMMATION - ONSET OF	:	
SYMPTOMS OF CARPAL TUNNEL	:	
SYNDROME OR ARTHRITIS - TACTILE	:	
DEFICIT OF FINGERS, AND	:	
INCREASES DISCOVERY OF FOREIGN	:	
MASS IN BREAST AND OTHER SELF	:	
EXAMINATIONS	:	

This is a decision on the petition filed March 3, 2008, pursuant to 37 C.F.R. § 1.137(a)<sup>1</sup>, to revive the above-identified application.

Background

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed October 13, 2006, which set a shortened statutory period for

<sup>1</sup> A grantable petition pursuant to 37 C.F.R. § 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in 37 C.F.R. § 1.17(l);
- (3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable;
- (4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to paragraph (d) of this section.

reply of three months. No response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on January 14, 2007. A notice of abandonment was mailed on September 12, 2007.

### Procedural History

A petition pursuant to 37 C.F.R. § 1.183 was filed on April 16, 2007, which was dismissed via the mailing of a decision on August 6, 2007 for failure to include the required petition fee.

An original petition pursuant to 37 C.F.R. § 1.181 was filed on October 1, 2007, and was dismissed via the mailing of a decision on October 26, 2007.

A renewed petition pursuant to 37 C.F.R. § 1.181 was filed on December 14, 2007, and was dismissed via the mailing of a decision on February 19, 2008.

### The Applicable Standard

**Nonawareness of a PTO rule will not constitute unavoidable delay<sup>2</sup>**

The burden of showing the cause of the delay is on the person seeking to revive the application<sup>3</sup>.

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."<sup>4</sup>

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<sup>2</sup> See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel. See also Donnelley v. Dickinson, 123 Fsupp2d 456, 459.

<sup>3</sup> Id.

<sup>4</sup> See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action<sup>5</sup>.

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"<sup>6</sup>

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present<sup>7</sup>.

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable"<sup>8</sup>.

#### Relevant Portions of The C.F.R. and M.P.E.P.

37 C.F.R. § 1.4(c) sets forth, *in toto*:

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must (emphasis added) be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

37 C.F.R. § 1.8 sets forth, *in pertinent part*:

(a) Except in the situations enumerated in paragraph (a)(2) of this section or as otherwise expressly excluded in this chapter, correspondence required to be filed in the U.S. Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

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<sup>5</sup> See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

<sup>6</sup> See In re Mattullah, 38 App. D.C. 497 (D.C. Cir. 1912).

<sup>7</sup> In re Mattullah, 38 App. D.C. at (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

<sup>8</sup> Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

(1) Correspondence will be considered as being timely filed if:

- (i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:
  - (A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail; or
  - (B) Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d); and
- (ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

...

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

37 C.F.R. § 1.134 sets forth, *in toto*:

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135 sets forth, *in toto*:

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last

action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

M.P.E.P. § 601.03 sets forth, *in pertinent part*:

The required notification of change of correspondence address need take no particular form. However, it should be provided in a manner calling attention to the fact that a change of address is being made. Thus, the mere inclusion, in a paper being filed for another purpose, of an address which is different from the previously provided correspondence address, without mention of the fact that an address change is being made would not ordinarily be recognized or deemed as instructions to change the correspondence address on the file record (emphasis added).

#### ANALYSIS

With this petition, Petitioner has met the first two requirements of Rule 1.137(a). The fourth requirement is not applicable. Regarding the third requirement, it has not been established that the entire period of delay was unavoidable.

Petitioner has set forth that he failed to receive the non-final Office action of October 13, 2006. He has set forth that he placed a forwarding order with the USPS to forward all mail from an address in Connecticut, however it does not appear that he has indicated when this forwarding order was placed, when his move occurred, or where the forwarding order directed the USPS to send mail.

Petitioner has further indicated that he

notified the USPTO of my change of address in a response filed a few weeks before the October 13, 2006 office action, but this was ignored in the Oct 13th 2006 office action.<sup>9</sup>

Petitioner appears to be referring to the fact that the header that appears on the cover sheet that was submitted with the election of species on September 5, 2006 contains two addresses, along with the notation "Note Change of Address."

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<sup>9</sup> Petition, page 1.

It does not appear that the Office noticed this request for a change of address, due to the fact that the request was not made in a prominent manner. This is precisely the reason that M.P.E.P. § 601.03, reproduced above, recommends that any request to change the correspondence address should be made in prominent manner, and should not be merely included within a paper "being filed for another purpose."

Moreover, even if the Office had recognized this request to change the correspondence address, it could not have been entered, as the request was contained within another paper, in contravention to Rule 1.4(c).

Petitioner failed to receive the Office action of October 13, 2006, and first learned of the communication via Public Pair on or about April 7, 2007 - just 6 days prior to the expiration of the maximum extendable period for response. Petitioner deposited his election of species 5 days later, along with a three-month extension of time, with the USPS in Arlington, Virginia on April 12, 2007<sup>10</sup>. Petitioner did not place a certificate of mailing on the submission, which was received on April 16, 2007.

Since the paper was received subsequent to the maximum extendable period for response, the petition for an extension of time could not have been granted. Consequently, this response could not have been accepted, since the application went abandoned by operation of law on January 14, 2007.

An extension of time under 37 C.F.R. § 1.136 must be filed prior to the expiration of the maximum extendable period for reply<sup>11</sup>. Accordingly, since the \$ 510 extension of time submitted with the election of species on April 16, 2007 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be refunded via the mailing of a Treasury Check in due course.

Petitioner has set forth that the entire period of delay was unavoidable, due to the fact that he submitted the extension fees, he had a certified mail receipt from the USPS<sup>12</sup>, and due to the close proximity of Arlington to Alexandria, he had a "reasonable basis to expect the response to be delivered the next day on April 13, 2007<sup>13</sup>."

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10 Petition of October 1, 2007, page 2.

11 See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988).

12 The certified mail receipt is dated April 12, 2007, and was included with the petition of October 1, 2007.

13 Petition, Page 2.

Regarding the petition for an extension of time, this matter has been addressed in this decision. Regarding the certified mail receipt, Rule § 1.8(a) indicates that the actual date of receipt in the Office is what determines whether a particular piece of correspondence was timely filed (if a certificate of mailing is not placed on the correspondence). See page 4 of the decision of October 26, 2007. Regarding the expectation as to the time it would take the USPS to deliver this response, this matter was addressed on page 4 of the decision of October 26, 2007.

As set forth above, when determining whether an entire period of delay was unavoidable, the general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"

In this case, it does not appear that Petitioner acted as a reasonable and prudent person in relation to his most important business. A reasonable and prudent person, acting in relation to his most important business, would have submitted a change of correspondence address in accordance with 37 C.F.R. § 1.4(c) and M.P.E.P. § 601.03, and would have placed a certificate of mailing on his response to the Office.

#### CONCLUSION

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.137(a)." This is not a final agency action within the meaning of 5 U.S.C § 704.

Alternatively, Petitioner may wish to submit a petition pursuant to Rule 1.137(b), which carries with it a much lower standard that a petition that is filed pursuant to 37 C.F.R. § 1.137(a).

Any response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail<sup>14</sup>, hand-delivery<sup>15</sup>, or facsimile<sup>16</sup>.

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14 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

15 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

16 (571) 273-8300- please note this is a central facsimile number.

Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web<sup>17</sup>.

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225<sup>18</sup>. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

/Paul Shanoski/

Paul Shanoski

Senior Attorney

Office of Petitions

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<sup>17</sup> <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

<sup>18</sup> Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.